

REMARKS

Claims 1-2 and 5-45 are pending in the instant application. Claims 1-2 and 5-45 have been rejected by the Examiner. Claims 1, 9, 18, 25-29, 31, and 39 have been amended. Claim 30 has been cancelled. The Applicants submit that claims 1, 2, 5-29, and 31-45 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections. No new matter has been entered by this amendment.

Rejections Under 35 USC § 102

Claims 1, 2, 5-10, 17, 18, and 25-44 have been rejected under 35 U.S.C. 102(e) as being allegedly anticipated by U.S. Publication No. 2003/0033288 to Shanahan et al. (hereinafter “Shanahan”). Claims 1, 9, 18, 25-29, 31 and 39 have been amended and claim 30 has been cancelled.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the * * * claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Applicants submit that claims 1, 2, 5-10, 17, 18, and 25-44 are not anticipated by Shanahan because Shanahan does not teach or suggest each and every element recited in the Applicants’ claims.

Claims 18 and 39 are directed to an “on demand” functionality, wherein a user may access the invention software from a central server on a “pay-as-you-go” basis (see pages 30-35, paragraphs [0061] through [0070] and corresponding Figures 10A and 10B). Claims 18 and 39 have been amended to include a portion of the features previously recited in claims 1 and 31, respectively. Thus, no new matter has been entered by these amendments. Amended claims 18 and 39 recite, *inter alia*, a method and storage medium, respectively, for providing web-based electronic research and presentation functions via a document creation application, “comprising *on demand sharing of process software* for providing said web-based electronic research and presentation functions via a document creation application, said on demand sharing comprising: creating a transaction containing unique customer identification, requested service type, and service parameters; sending said transaction to at least one main server; *querying said at least*

one main server about processing capacity associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction; and allocating additional processing capacity when additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity, and storage capacity.”

With respect to claims 18 and 39, the Examiner states that Shanahan discloses sharing of process software for providing said web-based electronic research and presentation functions via a document creation application, citing paragraph [0154] in support. In fact, paragraph [0154] of Shanahan makes a general reference to a meta-document server 200. The meta-document server 200 utilizes personalities assigned to a document for “assisting a user in the acquisition, sharing and utilization of knowledge.” Thus, at best, the teachings of Shanahan are limited to sharing knowledge via the meta-document server 200 and are entirely devoid of *sharing process software* as recited in claims 18 and 39.

In addition, the Examiner states that Shanahan teaches creating a transaction containing unique customer identification, requested service type, and service parameters, citing the unique user accessible identification number in paragraph [0171]. The portion of Shanahan relied upon by the Examiner discloses electronic tags 504, which are physical devices such as a small radio frequency transponder, which communicates electronically with tag readers 506. Thus, there is no teaching of creating a transaction that contains a unique customer identification, requested service type, and service parameters as recited in claims 18 and 39.

The Examiner further states that Shanahan teaches sending said transaction to at least one main server, citing ‘transmit’ and ‘server’ in paragraph [0181]. However, paragraph [0181] merely discloses transmitting a timestamp and location data to the meta-document server 200. As indicated above, the claimed transaction comprises a unique customer identification, requested service type, and service parameters. Thus, Shanahan fails to teach sending said transaction to at least one main server as recited in claims 18 and 39.

Moreover, the Examiner states that Shanahan discloses querying said at least one main server about processing capacity associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction, citing paragraph [0287] in support. However,

this portion of Shanahan simply discloses a process by which a question is submitted to an information service, and by which an answer is returned. There is no teaching or suggestion of *querying the server about processing capacity* to ensure availability of adequate resources for processing the transaction as recited in claims 18 and 39.

Further, the Examiner states that Shanahan teaches allocating additional processing capacity when additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity, and storage capacity, citing paragraph [0588] in support. In fact, this portion of Shanahan merely discloses hardware components of the meta-document server 200 that include CPU, RAM, ROM, I/O devices, etc. Shanahan is entirely devoid of teaching *allocating additional processing capacity* when addition capacity appears need to process said transaction as recited in claims 18 and 39.

For at least the aforementioned reasons, the Applicants submit that claims 18 and 39 are not anticipated by Shanahan and are furthermore, allowable to Applicants. Claim 25 recites a system for providing web-based electronic research and presentation functions via a document creation application and has been amended in a similar manner as claims 18 and 39. For at least the reasons advanced above with respect to claims 18 and 39, the Applicants submit that 25 is also in condition for allowance. Claims 1, 2, 5-10, and 17 depend from what should be an allowable base claim 18. Claims 26-29 depend from what should be an allowable base claim 25. Claims 31-38 and 40-44 depend from what should be an allowable base claim 39. For at least reasons due to their dependencies on allowable base claims, the Applicants submit that claims 1, 2, 5-10, 17, 26-29, 31-38, and 40-44 are also in condition for allowance. Reconsideration and withdrawal of the rejections of claims 1, 2, 5-10, 17, 18, 25-29, and 31-44 is respectfully requested.

Claim Rejections Under 35 USC § 103

Claims 11-16 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shanahan in view of U.S. Patent No. 6,192,381 issued to Stiegemeier et al. (hereinafter “Stiegemeier”). In addition, claims 19-22 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shanahan in view of U.S. Publication No. 2003/0033253 to Rhodes (hereinafter “Rhodes”). Also, claims 23, 24, and 45 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Shanahan in view of U.S. Publication No. 2002/0065849 to Ferguson et al. (hereinafter “Ferguson”).

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

These rejections are respectfully traversed because the prior art references do not teach or suggest all of the claim limitations and additionally or alternatively, because none of the references contain any suggestion or motivation to one of ordinary skill in the art to modify or combine the references.

Claim 11 recites, “***deploying process software for providing said web-based electronic research and presentation functions via a document creation application***, said deploying comprising: installing said process software on at least one server; identifying server addresses for users accessing said process software on said at least one server; installing a proxy server if needed; sending said process software to said at least one server and copying said process software to a file system of said at least one server; sending the process software to at least a first client computer; and executing said process software on said first client computer.”

With respect to claim 11, the Examiner states that Shanahan teaches all of the elements recited therein with the exception of a proxy server, for which he relies on Steigemeier as allegedly teaching. As indicated above with respect to claim 18 from which claim 11 depends, Shanahan is devoid of teaching ***on demand sharing of process software*** for providing said web-based electronic research and presentation functions. Thus, Shanahan may not properly be relied upon for teaching ***deploying process software*** for providing said web-based electronic research and presentation functions via a document creation application, as recited in claim 11. As Shanahan does not teach deploying process software as recited in claim 11, the Applicants submit that the introduction of Steigemeier as allegedly teaching a proxy server would not cure the aforementioned deficiencies of Shanahan. For at least this reason, the Applicants submit that claim 11 is patentable over Shanahan in view of Steigemeier. Claims 12-16 depend from what should be an allowable claim 11. For at least this reason, the Applicants submit that claims 12-16 are in condition for allowance. Reconsideration and withdrawal of the outstanding rejections is respectfully requested.

Claim 19 recites, ***inter alia***, “recording a plurality of usage measurements selected from the group of usage measurements consisting of network bandwidth, processor memory, storage, and central processing unit cycles.” The Examiner states that Shanahan teaches the features of claim 19 except it does not explicitly teach “usage measurements.” The Examiner relies upon Rhodes for allegedly teaching this feature. As indicated above with respect to claim 18 from which claim 19 depends, Shanahan does not teach “***querying said at least one main server about processing capacity*** associated with said at least one main server to help ensure availability of adequate resources for processing of said transaction; ***and allocating additional processing capacity when***

additional capacity appears needed to process said transaction, said additional processing capacity being selected from the group of *additional capacities consisting of central processing unit capacity, processor memory capacity, network bandwidth capacity, and storage capacity*.” Rather, Shanahan simply discloses a process by which a question is submitted to an information service, and by which an answer is returned. There is no teaching or suggestion of *querying the server about processing capacity* to ensure availability of adequate resources for processing the transaction. Moreover, Shanahan teaches hardware components of the meta-document server 200 that include CPU, RAM, ROM, I/O devices, etc., but is entirely devoid of teaching *allocating additional processing capacity* when addition capacity appears need to process said transaction. As Shanahan does not teach querying the server about processing capacity and allocating additional processing capacity, it follows that the introduction of Rhodes for allegedly teaching tracking usage measurements would not cure the aforementioned deficiencies of Shanahan.

The Examiner further states that it would have been obvious to one of ordinary skill in the art at the time of Applicants’ invention to combine Rhodes and Shanahan to produce the claimed invention. The Applicants respectfully disagree. Rhodes is directed to a system and method for tracking use of computer network service, allowing use beyond a threshold value to be quantified and subsequently billed to a service subscriber. Shanahan is silent regarding how users are billed for use of the server 200. Billing of users of the system of Shanahan is an issue not considered by Shanahan. The Examiner offers two motivations to combine Rhodes and Shanahan. First, the Examiner states that one of ordinary skill in the art would have been motivated to make the proposed combination “to control potential network congestion due to overload of service provider’s network by the heavy users,” citing Rhodes paragraph [0007]. However, Shanahan, directed to an entirely different problem than Rhodes, does not suggest that “network congestion” due to “heavy users” is a problem relevant to the invention of Shanahan. Second, the Examiner asserts that the person of ordinary skill would have been motivated to make the proposed combination “to model a usage analysis system and method for the subscriber by defining a threshold value,” citing Rhodes, paragraph [0016]. Again, Shanahan is silent regarding “usage analysis”, a “subscriber”, a “threshold value” or any related concepts. The person of ordinary skill in the art would not recognize these aspects of Rhodes (relevant to providers of computer network services) as being relevant to the

invention of Shanahan. For at least these reasons, the Applicants submit that the cited references, coupled with knowledge generally available in the art at the time of the invention, do not contain any suggestion or incentive that would have motivated the skilled artisan to modify the reference or combined references. Accordingly, the Applicants submit that claim 19 is patentable over Shanahan in view of Rhodes. Claims 20-22, as depending from what should be an allowable claim 19, should also be in condition for allowance.

On page 5 of the Office Action, the Examiner indicated that claims 40-43 are rejected under 35 U.S.C. 102(e). However, it is believed that the Examiner's intent was to reject claims 40-43 under 35 U.S.C. 103(a) as being unpatentable over Shanahan in view of Rhodes (see pages 18-19 of the Office Action). Accordingly, the Applicants will address these claims as being rejected under 35 U.S.C. 103(a). Claims 40-43 recite substantially similar features as those recited in claims 19-22. For at least the reasons advanced above with respect to claims 19-22, the Applicants submit that claims 40-43 are also in condition for allowance. Reconsideration and withdrawal of the rejections of claims 19-22 and 40-43 is respectfully requested.

With respect to claims 23, 24, and 45, the Examiner states that the combination of Shanahan and Ferguson teaches each of the features recited therein. Claims 23 and 24 depend from what should be an allowable claim 18. Claim 45 depends from what should be an allowable claim 39. For at least these reasons, the Applicants submit that claims 23, 24, and 45 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections.

CONCLUSION

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested. It is submitted that the foregoing amendments and remarks should render the case in condition for allowance.

Accordingly, as the cited references neither anticipate nor render obvious that which the Applicants deem to be the invention, it is respectfully requested that claims 1, 2, 5-29, and 31-45 be passed to issue.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 09-0458.

Respectfully submitted,

EDWARD E. KELLEY, ET AL.

CANTOR COLBURN LLP
Applicants' Attorneys

By /Marisa J. Dubuc/

Marisa J. Dubuc

Registration No. 46,673

Customer No. 29371

Date: January 19, 2007

Address: 55 Griffin Road South
Bloomfield, CT 06002

Telephone: (860) 286-2929

Fax: (860) 286-0115